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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,426	06/15/2001	Hugh Boyd Morrison	RCA 89186	1414
7590 Joseph S Tripoli Thomson multimedia Licensing Inc PO Box 5312 Princeton, NJ 08540			EXAMINER SALTARELLI, DOMINIC D	
			ART UNIT 2421	PAPER NUMBER
			MAIL DATE 12/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/868,426

Applicant(s)

MORRISON ET AL.

Examiner

DOMINIC D. SALTARELLI

Art Unit

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No./Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 9, 2008 have been fully considered but they are not persuasive.

First, applicant argues that because Berry fails to disclose the use of "electronic email messages" or the desirability of scheduling an event, the combination of Hirata, Westlake, and Berry fails to teach the claimed invention.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, each of the particular features which applicant argues as missing from Berry are addressed with the combination of Hirata and Westlake. The final modification made to the Hirata and Westlake combination is an adjustment to the order and conditions upon which each of the two disclosed searches taught by Hirata and Westlake take place.

Second, applicant argues that Berry is non-analogous art and thus improper for use in an obviousness rejection under 35 U.S.C. 103(a).

In response, both Hirata and Westlake teach searching methods for identifying desired text strings within a text document (see Hirata, col. 6, lines 21-63 and Westlake, fig. 3). This is undeniably analogous to Berry, who is

exclusively concerned with teaching an improved searching method for identifying desired text strings with a text document (see Berry, col. 2, lines 20-26).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata (6,374,406, of record) in view of Westlake et al. (WO 99/35847, of record) and Berry et al. (5,375,235, of record) [Berry].

Regarding claims 10, 17, and 24, Hirata discloses a method and apparatus comprising:

receiving an electronic mail message remotely from a user (col. 5, lines 10-18, 65-67), said electronic mail message comprising an operating command ('control command', col. 6, lines 21-39) and program identification information including a first type of program identification information (col. 7, lines 6-20);

processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information (col. 6, lines 40-55); and

scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information (col. 7, lines 49-53 and col. 9, lines 24-65).

Hirata fails to disclose continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information, searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information, and scheduling said event if said program is found during said searching step.

In an analogous art, Westlake teaches automatically scheduling the operation of a video processing apparatus ('automatic implementation' page 34, lines 2-9, of recording or reminder operations, page 26, lines 7-23) by determining if a received electronic mail message includes a second type of program type identification information and searching program guide information for an identified program using said program identification information (such as program title, page 23, lines 14-28) and scheduling said event if said program is found during said search (page 25 line 24 – page 26 line 23), providing the

benefit of providing a means for transmitting programming information via an electronic message for programming a video processing apparatus that is less prone to errors possibly made from the transmitter side (page 3 line 17 – page 4 line 26).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and apparatus disclosed by Hirata to include processing said electronic mail message to determine whether said electronic mail message includes said second type of program identification information if said electronic mail message does not include said first type of program identification information (which would otherwise lead to an error message, see Hirata, col. 6, lines 40-55), searching said program guide information for said program using said program identification information if said electronic mail message includes said second type of program identification information, and scheduling said event if said program is found during said searching step, as taught by Westlake, for the benefit of providing a means for transmitting programming information via an electronic message for programming a video processing apparatus that is less prone to errors possibly made from the transmitter side.

Hirata and Westlake fail to disclose continuing to process the electronic mail message only if the first type of program identification information is not included.

In an analogous art, Berry teaches performing a searching operation, where a search is first performed for a first type of information, and only

broadens the search for a second type of information if a match is not found in the first search, providing the benefit of improved speed by avoiding unnecessary searching (wherein a first type of words are highly specific and are located quickly, whereas a second type of words are less specific and require more processor intensive searching, therefore the type 1 words are given priority, and additional searching is done one if a type 1 word is not found, col. 4, lines 3-9 and col. 5 line 36 - col. 6 line 19).

It would have been obvious at the time to a person of ordinary skill in the art to perform additional searching only if a match is not found in the first search, as taught by Berry, for the benefit of avoiding unnecessary searching, which streamlines the searching for improved efficiency.

Regarding claims, 11, 18, and 25, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, wherein said first type of program identification information includes channel and time information for said program (Hirata, col. 7, lines 11-20) and said second type of program identification information includes a name of said program ('title', Westlake, page 23, lines 21-25).

Regarding claims 12, 19, and 26, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, wherein said operating command represents one of a request to record said program ('VIDEO

Reservation', Hirata, col. 6, lines 33-39) and a request to watch said program (Westlake, page 26, lines 13-23).

Regarding claims 13, 20, and 27, Hirata, Westlake, and Berry disclose the method and apparatus of claims 12, 19, and 26, wherein said video processing apparatus is scheduled to record said program if said operating command represents said request to record said program (Hirata, col. 9, lines 18-30) and said video processing apparatus is scheduled to power on if said operating command represents said request to watch said program (Hirata teaches powering on the video equipment to implement the operating command if it is not already on, col. 9, lines 54-60).

Regarding claims 14, 21, and 28, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, further comprising sending a second electronic mail message from said video processing apparatus to said user if said program is not found during said searching step, said second electronic mail message indicating that said electronic mail message included insufficient program identification information (Hirata teaches sending response emails which provide the details of an error if an error is encountered, col. 6, lines 40-55 and fig. 6).

Regarding claims 15, 22, and 28, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, but fail to disclose said electronic mail message further comprises a password and further comprising a step of sending a second electronic mail message from said video processing apparatus to said user if said password is incorrect.

It is notoriously well known in the art to password protect systems for the benefit of user verification, and it would have been obvious at the time to a person of ordinary skill in the art to modify the method and apparatus of Hirata, Westlake, and Berry to include a password in the electronic email message. This would further comprise sending a second electronic mail message from said video processing apparatus to said user if said password is incorrect because Hirata teaches sending response emails which provide the details of an error if an error is encountered (Hirata, col. 6, lines 40-55 and fig. 6).

Regarding claim 16, 23, and 29, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, further comprising sending a second electronic mail message from said video processing apparatus if said event is scheduled (Hirata, fig. 7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is

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(571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dominic D Saltarelli/
Examiner, Art Unit 2421